

Application No. 09/385,802
Attorney Docket No. 4031/1 - 15719US00

REMARKS

The present application includes claims 16-20, 22, and 103-121. Claims 16-20, 22, and 103-121 were rejected. By this Amendment, claim 104 has been canceled, claims 16-18, 112-114, and 118 have been amended, and new claims 122-127 have been added.

I. The Rejection Of Claim 17 As Being Indefinite

Claim 17 was rejected under 35 U.S.C. § 112, second paragraph as indefinite because the clause "the IM database" lacked antecedent basis. Claim 17 has been amended to provide antecedent basis. Additionally, claim 18 has also been amended to provide antecedent basis.

II. The Rejection Of Claims 16-20, 22, 103, 112, And 113 As Being Anticipated by Aravamudan

The Applicant now turns to the rejection of claims 16-20, 22, 103, 112, and 113 under 35 U.S.C. § 102(e) as being anticipated by Aravamudan, U.S. Patent No. 6,301,609.

Aravamudan does NOT teach Instant Messaging (IM) between two users. Instead, all IM takes place between a user and the Communication Services Platform (CSP). As described beginning at Col. 5, Line 15, the IM server is an industry standard server, but the CSP is registered as a "buddy" of the subscribing client (user). As described beginning at Col. 6, Line 64 and shown in Figure 5, when a user logs onto the network using one of the user's Client Premises Equipment (CPE), software installed on

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the CPE detects the network activity and sends a message to the IM server indicating that the user is online. The IM server then notifies the CSP that the user is online and the CSP checks for pending events that were held in abeyance while the user was offline, as described at Col. 7, Lines 20-25. Several examples of pending events, such as voicemail messages, are mentioned, but IMs from another user are not addressed.

As described beginning at Col. 7, Line 33, if the CSP has no pending events, then the CSP IM session is terminated. However, if the CSP does have pending events, then the IM server sends an IM to the user's CPE device communicating the event and eliciting a user response.

Additionally, as described beginning at Col. 8, Line 10, while a user is online, the IM server periodically polls the user's CPE to confirm that the user is online. If the IM server confirms that the user is no longer online, then the IM server sends an IM to the CSP informing the CSP that the user is no longer online. Conversely, if the IM server confirms that the user is still online, then the IM server does not send the IM.

Thus, in Aravamudan, the IM server is not used to facilitate IM sessions between two users. Instead, the IM server is used when the user logs on to send an IM alert to the user that alerts the user to pending events like a voice mail message, for example.

Additionally, in the most recent Office Action, the Examiner points to Figure 3 and elements 184 and 192 as teaching first and second users communicating using IM. However, Figure 3 illustrates a system for converting circuit voice traffic to IP voice

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traffic (packet based) and is not concerned with the transmissions of IMs between users. That is, as discussed beginning at Col. 3, Line 64, Figure 3 illustrates a plurality of circuit voice traffic connections 182 conveyed over the PSTN backbone 184 via regular PSTN circuit switches that terminate their PSTN transmissions at a Synchronous Transfer Mode (STM) switch 180. Conversion from circuit voice traffic to IP voice traffic takes place at the gateway 186. The gateway 186 then forwards the converted packets to an edge device IP router 188.

Turning now to the claims, claims 16-20, 22, 103, 112, and 113 were rejected by the Examiner in light of Aravamudan and include independent claims 16, 112, and 113. Independent claim 16 recites establishing a connection between a first user and a second user as part of an instant messaging session. This limitation is not taught by Aravamudan because Aravamudan only teaches sending IMs between a user's CPE and an IM server, not between two users. Similarly, claim 112 recites establishing a connection from a first user to a second user as part of an IM session, which is also not taught by Aravamudan. Further, claim 113 recites displaying an IM from a first user to a second user, which is also not taught by Aravamudan.

Thus, it is respectfully submitted that claims 16, 112, and 113 are allowable and that their respective dependent claims are allowable as well.

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Additionally, claim 16 has been amended to recite the limitation of dependent claim 104 of encrypting an instant message during the instant messaging session. This limitation is not taught by Aravamudan, as reflected in the fact that claim 104 was not rejected by the Examiner in light of Aravamudan. However, the limitation was added to claim 16 in light of the rejection under Auerbach and Kim as discussed below.

Additionally, claims 112 and 113 have been amended to clarify that the first realm employs a first IM protocol and the second realm employs a second, different, IM protocol. This was done because, in the Office Action, the Examiner appeared to identify a PSTN network as a first protocol characteristic and an IP network as the second protocol characteristic. The present amendment should clarify that such an interpretation is outside the scope of the claim.

III. The Rejection Of Claims 104-111 And 114-121 As Being Unpatentable Over Aravamudan In View Of Gudjonsson

The Applicant now turns to the rejection of claims 104-111 and 114-121 under 35 U.S.C. § 103(a) as being unpatentable over Aravamudan in view of Gudjonsson, U.S. Patent No. 6,564,261.

Gudjonsson has been cited as teaching the transmission of encrypted IM, but Gudjonsson does not teach encrypting IM and is not even an IM system. Instead, as recited in the Summary starting at Col. 2, Line 51, Gudjonsson teaches a loosely confederated network of server clusters and client terminals that connect to the clusters. Gudjonsson does mention that the connection between a terminal and a cluster may be

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encrypted in several locations, such as at Col. 2, Lines 65-67. However, Gudjonsson does not teach the transmission of IMs at all, further does not teach the transmission of IMs between two users, and still further does not teach the transmission of encrypted IMs between two users.

Instead, Gudjonsson mentions an IM system in the background (the section indicated by the Examiner) to point out the IM system's shortcomings and specifically differentiate Gudjonsson's system from an IM system (Col. 2, Lines 35-48). Even so, there is no mention of encrypted IMs in the background.

The only other citation by the Examiner is Col. 11, Lines 38-43, which recites that the connection between a client 11 and a server 3 may be encrypted in the system of Gudjonsson. However, there is no mention of Gudjonsson's system transmitting IMs and further there is no teaching of transmitting encrypted IMs between two users.

Further, as mentioned above, although Aravamudan teaches an IM server, the IM server is not used to facilitate IM sessions between two users. Instead, the IM server is used when the user logs on to send an IM alert to the user that alerts the user to pending events like a voice mail message, for example. Aravamudan also does not teach encrypting an IM. However, even if Aravamudan did teach encrypting an IM, Aravamudan would not teach encrypting an IM passing between two users because Aravamudan only passes IMs between a user and an IM server.

Thus, neither Aravamudan nor Gudjonsson teaches encrypting IMs.

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The rejected claims 104-111 and 114-121 include independent claims 108, 114, and 118. Claims 108, 114, and 118 all include the limitation of encrypting communications in an IM session between two user devices, which is not taught by Aravamudan nor Gudjonsson, alone or in combination. Thus, it is respectfully submitted that claims 108, 114, and 118 are allowable and that their respective dependent claims are allowable as well.

IV. The Rejection Of Claims 16 And 22 As Being Unpatentable Over Auerbach In View Of Kim

The Applicant now turns to the rejection of claims 16 and 22 under 35 U.S.C. § 103(a) as being unpatentable over Auerbach, U.S. Patent No. 6,549,937 in view of Kim, U.S. Patent No. 6,490,274.

Claim 16 has been amended to include the limitation of dependent claim 104 of encrypting an instant message during the instant messaging session. Claim 104 has been canceled. This limitation is not taught by Auerbach or Kim, as reflected in the fact that claim 104 was not rejected by the Examiner in light of Auerbach or Kim.

Consequently, the present rejection is now moot and claim 16 and its dependent claim 22 are respectfully submitted to be allowable.

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V. The Rejection Of Claims 17-20 And 103 As Being Unpatentable Over Auerbach And Kim In View Of Appelman

The Applicant now turns to the rejection of claims 17-20 and 103 under 35 U.S.C. § 103(a) as being unpatentable over Auerbach and Kim in view of Appelman, U.S. Patent No. 6,750,881.

Claims 17-20 and 103 depend from claim 16 which was respectfully submitted to be allowable above. Consequently, dependent claims 17-20 and 103 are also respectfully submitted to be allowable.

Additionally, claims 114 and 118 have been amended for clarity. However, the language eliminated from claims 114 and 118 appears in dependent claims 122 and 125 respectively, so as to maintain consistency for the Examiner.

Also, new dependent claims 123-124 and 126-127 are similar to claims 17 and 22, but depend from independent claims 114 and 118 respectively.

Finally, Applicant wishes to inform the Examiner that a Supplemental IDS will be filed soon in the present application. Applicant respectfully requests that the Examiner review the contents of the Supplemental IDS before proceeding with examination.

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CONCLUSION

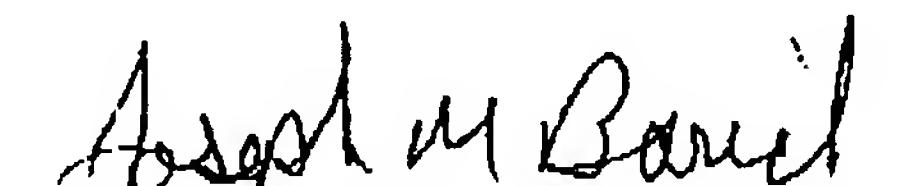
In light of the above, it is respectfully submitted that the pending claims are allowable over the cited art. If the amendments and remarks above are believed to be insufficient for allowance, a personal interview is respectfully requested to advance the prosecution of the patent application.

If the Examiner has any questions or the Applicant can be of any assistance, the Examiner is invited and encouraged to contact the Applicant at the number below.

The Commissioner is authorized to charge any necessary fees or credit any overpayment to the Deposit Account of McAndrews, Held & Malloy, Account No. 13-0017.

Respectfully submitted,

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